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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,173	09/17/2003	Sheila Farrokhlaee Kia	GP-302380	3329
7590 10/24/2005 KATHRYN A MARRA General Motors Corporation Legal Staff, Mail Code 482-C23-B21 P.O. Box 300 Detroit, MI 48265-3000			EXAMINER BIRENBAUM, NIRA S	
			ART UNIT 1742	PAPER NUMBER
DATE MAILED: 10/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/664,173

Applicant(s)

KIA ET AL.

Examiner

Nira S. Birenbaum, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 and 7-10, drawn to a method, classified in class 205, subclass 324.
- II. Claims 4-6, drawn to a product, classified in class 296, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case a decorative automobile body can be made by another process, for example, the anodized aluminum parts can be colored by painting instead of by electrolytic coloring.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kathryn A. Marra on October 3, 2005 a provisional election was made with traverse to prosecute the invention of I, claims 1-3 and 7-10. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 4-6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: in line 12 of the claim, the phrase "to form" is repeated. Appropriate correction is required.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-3 and 7-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,884,336. The method steps recited in the instant application are encompassed by those of the '336 patent.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartkowski *et al* (US Patent No. 5,102,508).

Regarding claim 1, Bartkowski *et al*. teach a method for producing colored surfaces on aluminum parts comprising:

- anodizing aluminum parts in an acidic solution (column 1, lines 60-62)
- coloring the anodized surfaces electrolytically (column 1, lines 63-68)

However, this reference does not expressly teach the step of making an automotive vehicle body or decorative component parts out of aluminum.

It would have been obvious to one of ordinary skill in the art at the time of the invention to form the aluminum parts taught by Bartkowski *et al*. into vehicle body parts, because Bartkowski *et al*. teach that aluminum parts are frequently used in automobile manufacture (column 1, lines 11-17).

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Regarding claim 7, Bartkowski teaches a method for producing colored surfaces on aluminum parts comprising:

- cleaning aluminum parts to remove materials which inhibit anodizing (column 1, lines 51-55)
- anodizing the parts in an acidic solution to form a porous oxide layer 12  $\mu\text{m}$  thick (column 2, lines 51-65)

However, this reference does not expressly teach the step of making an automotive vehicle body or decorative component parts out of aluminum.

It would have been obvious to one of ordinary skill in the art at the time of the invention to form the aluminum parts taught by Bartkowski *et al.* into vehicle body parts, because Bartkowski *et al.* teach that aluminum parts are frequently used in automobile manufacture (column 1, lines 11-17).

Regarding claim 8, Bartkowski *et al.* teach that the anodized parts are colored by electrolytically depositing tin in the pores of the oxide surface (column 3, lines 18-20).

Regarding claims 9 and 10, Bartkowski *et al.* teach that the parts are colored by dipping them into an acidic aqueous bath of tin sulfate and electrolytically depositing tin inside the pores of the oxide surface (column 3, lines 5-20).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartkowski *et al.* in view of Gruninger (US Patent No. 4,648,911).

Bartokowski teaches the features as previously described. However, this reference does not teach cold sealing the colored aluminum parts. Gruninger teaches a process for sealing the surface of anodized aluminum parts comprising treating the

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anodized surface with a solution containing at least one nickel salt and at least one fluoride at a temperature below 30° (column 2, lines 1-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Bartkowski *et al.* by cold sealing the aluminum parts as disclosed by Gruninger, because Gruninger teaches that this sealing process is advantageous since it does not result in bath contamination and that it gives outstanding sealing (column 1, lines 57-63).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartkowski *et al.* in view of Gruninger, further in view of Lowenheim (*Electroplating* McGraw-Hill Book Company, New York: **1978**, pp. 463-464).

Bartkowski *et al.* and Gruninger teach the features as previously described. However, these references do not teach hot sealing the anodized aluminum parts after coloring and cold sealing.

Lowenheim teaches a method for hot sealing anodized aluminum parts comprising immersing the parts in distilled or deionized boiling water at a temperature of 98°-100° C (pg. 463, paragraph 8 and pg. 464 paragraph 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Bartkowski *et al.* in view of Gruninger by hot sealing the aluminum surfaces as disclosed by Lowenheim, because Lowenheim teaches that the utility and performance of anodic coatings on aluminum depends on the type of post-anodizing treatment used *i.e.*, sealing (pg. 463, paragraph 2).

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nira S. Birenbaum, Ph.D. whose telephone number is (571) 272-8516. The examiner can normally be reached on M-F 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

nsb

ROY KING   
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